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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,967	06/22/2001	Mitsuhiro Kawazu	71896-55987	7676

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EDWARDS & ANGELL, LLP  
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BOSTON, MA 02209

EXAMINER

MCPHERSON, JOHN A

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS3

# Office Action Summary

Application No.

09/887,967

Applicant(s)

KAWAZU, MITSUHIRO

Examiner

John A. McPherson

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5 and 6 is/are objected to.
- 8) ☒ Claim(s) 1-7 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.                      6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, drawn to a method of producing a light absorbing pattern film coated article, classified in class 430, subclass 330.
  - II. Claim 7, drawn to a light absorbing pattern film coated article, classified in class 428, subclass 206.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, such as by a direct writing process (i.e. without a photomask).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

2. During a telephone conversation between David Conlin and Gwendolyn Blackwell-Rudasill on 5/22/02 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-6. Affirmation of this election must be

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made by applicant in replying to this Office action. Claim 7 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: it does not include a claim for benefit under 35 USC 120 to the parent PCT application.

### ***Claim Objections***

4. Claims 5-6 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may not depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, these claims have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 47-016816 (JP '816) [reference BA of the Information Disclosure Statement filed 6/22/01]. JP '816 discloses a process for the treatment of a coating film comprising the steps of coating a solution containing fine particles of a metal and a metal oxide, including gold and titanium oxide, on a substrate; irradiating the coated film to light in the presence of humidity; and sintering the obtained film. See the English translation of the claim; page 2, left column, lines 26-29; page 3, left column, line 40 to right column, line 7; and the Example.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000272935 (JP '935) [reference BD of the Information Disclosure Statement (IDS) filed 6/22/01] in view of either one of "Photoresponsive Formation of Gold particles in Silica/Titania Sol-Gel Films by Yanagi et al. (Yanagi) [reference CA of the IDS filed 6/22/01] or JP 6-191896 (JP '896) [reference BB of the IDS filed 6/22/01]. JP '935 discloses a method for the production of a colored membrane-covered glass material having various transmitted tones of colors comprising the steps of coating a silica-titania-based covering liquid on a glass substrate and heating the coated product,

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wherein the silica-titania-based covering liquid comprises gold fine particle raw material, silicon oxide raw material, and titanium oxide raw material, with the titanium oxide raw material comprising at least 50 wt% titanium oxide fine particles. See the abstract. However, JP '935 does not disclose patterning the film by exposing the gold containing silica-titania coating film to ultraviolet light through a photomask prior to heating.

Yanagi discloses a process for the photoresponsive formation of gold particles in silica-titania films comprising the steps of coating a film from a silica/titania precursor solution containing Au(III) ions, and exposing the coated films to ultraviolet light through a photomask. See the abstract, the paragraph bridging the right and left columns on page 1259. JP '896 discloses a process of changing the coloration tone of a coating comprising silicon alkoxide, titanium oxide raw material and gold salt comprising irradiating ultraviolet rays onto the coated film followed by baking. See the abstract and page 2, lines 2-19 of the present specification.

It would have been obvious to one skilled in the requisite art to expose a gold-containing silica-titania film to ultraviolet light through a mask, as taught by either one of Yanagi or JP '896, in the process of JP '935 because it is taught that irradiating a gold containing silica-titania coating through a mask provides for a controlled photodeposition process which enables the formation of micropatterns.

Applicant cannot rely upon the foreign priority papers (which have not been provided) to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

***Pertinent Prior Art***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,976,678 discloses colored film-covered glass articles including a glass substrate and a colored film covering the glass substrate, the colored film containing greater than 50 to 95 wt% silicon oxide, 0-30 wt% of at least one member selected from zirconium oxide, tantalum oxide and titanium oxide, 0-25 wt% cerium oxide and 5-20 wt% gold as coloring fine particles as main components.

U.S. Patent No. 4,134,747 discloses a method of forming transparent and opaque portions in a glass article, wherein the opaque portion is produced through the thermal reduction and precipitation of a controlled number of submicroscopic particles of at least one member selected from the group of copper, gold, palladium, platinum and silver, with the subsequent nucleation and growth of NaF crystals on the metal particles to a size sufficient to scatter visible light; and the transparent portion is developed through the photoreduction of at least one photosensitive metal selected from the group of copper, gold and silver to produce additional submicroscopic particles upon which NaF crystal are nucleated and grown, but which remain in a size too small to scatter visible light.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (703)

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308-2302. The examiner can normally be reached on Monday through Friday, 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (703) 308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



John A. McPherson  
Primary Examiner  
Art Unit 1756

JAM  
May 2, 2003